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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/778,963	02/08/01	NEELAM	B CL001112

025748 HM12/1030
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EXAMINER
CANELLA, K

ART UNIT	PAPER NUMBER
1642	

DATE MAILED: 10/30/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/778,963

Applicant(s)

Neelam et al

Examiner

Karen Canella

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-23 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 2, 20 and 21, drawn to the isolated polypeptide of SEQ ID NO:2, allelic variants, fragments and orthologs thereof, classified in, for example, class 514, subclass 21.
 - II. Claims 3 and 17, drawn to antibodies and agents which bind to the polypeptides of Invention I, classified in, for example, class 424, subclass 138.1.
 - III. Claims 4-6, 8-11, 22 and 23, drawn to isolated nucleic acids of SEQ ID NO:1 and 3, variants thereof and isolated nucleic acids which encode the polypeptides of Invention I, gene chip, vectors, host cells and recombinant expression thereof, classified in class 536, subclass 23.5, and 24.5 and class 435, subclasses 69.1, 252.3 and 320.1.
 - IV. Claim 7, drawn to a non-human transgenic animal comprising the nucleic acids which encode SEQ ID NO:2, allelic variants, fragments and ortholog, classified in class 800, subclass 8.
 - V. Claims 12, 14-16 and 19, in part, drawn to a method of detecting the polypeptides of Invention I, a method for identifying agents which bind to polypeptides of Invention I, methods for identifying modulators of the polypeptides of Invention I and a method for identifying a modulator of expression of the polypeptides, classified in class 435, subclass 7.1 and 7.8. Claim 19 will be examined with this group to the extent that it reads on the detection of a polypeptide.
 - VI. Claims 13 and 19, in part, drawn to a method for detecting nucleic acids and a method for identifying a modulator of the expression of the polypeptide of

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Invention I, classified in class 435, subclass 6. Claim 19 will be examined with this group to the extent that it reads on the detection of nucleic acids.

- VII. Claim 18, drawn to a method of treating a disease or condition, comprising administering to a patient a pharmaceutically effective amount of an agent which binds to the polypeptides of Invention I, classified in, for example, class 530, subclass 387.7.

2. The inventions are distinct, each from the other because of the following reasons:

The Inventions of Groups I, II, III and IV are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

The methods of Groups V, VI and VII differ in the method objectives, method steps and parameters and in the reagents used.

Inventions I, II and III are related, respectively, to Inventions V, VII and VI as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of Invention I can be used in a process to raise the antibody of Invention II; the antibody of Invention II can be used in a process for making an anti-idiotypic antibody; and, the nucleic acids of Invention III can be used in a process to make the non-human transgenic animal of Invention IV.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent


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subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


GEETHA BANSAL
PRIMER EXAMINER

Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

October 22, 2001